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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
10/009,453	11/05/2001	Bernd Fabry	H4132 PCT US	1938

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[REDACTED] EXAMINER

[REDACTED] WELLS, LAUREN Q

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

[REDACTED] 1617

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/009,453	FABRY ET AL.
	Examiner	Art Unit
	Lauren Q Wells	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 June 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 9-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 9-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claims 9-20 are pending. The Appeal Brief filed 6/6/03, Paper No. 12, is acknowledged. However, PROSECUTION IS HEREBY REOPENED in light of the new art found which reads on the instant invention. Thus, to avoid abandonment of the application, Applicant is respectfully requested to file a reply under 37 CFR 1.11 since this is a non-final Office Action.

Applicant's arguments, in regard to the 35 USC 103 rejection, with respect to claims 9-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments are persuasive to overcome the 35 USC 112 rejection in the previous Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9, 12-16, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ansmann et al. (WO 99/11235).

Ansmann et al. exemplify a sunscreen composition comprising octyl methoxycinnamate (cosmetically active ingredient) and 1% zinc stearate (metal soap), wherein Col. 3, lines 1-14, teach zinc stearate as a particle having a mean diameter of less than 100nm and preferably between 5 and 50nm. See Col. 8, lines 30-65. US 6,280,712 is relied upon as a translation for WO 99/11235.

Claims 15-20 are directed to a method of enhancing the stability, opacity and consistency of a composition comprising adding metal soap nanoparticles having a mean diameter of from 10-300nm. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches metal soap particles as ingredients in cosmetic compositions, which would inherently enhance the stability, opacity and consistency of a cosmetic composition as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. as applied to claims 9, 12-16, 18-20 above, and further in view of Miles (2,456,437).

The instant invention is directed to a composition comprising an active ingredient selected from cosmetically or pharmaceutically active ingredients, and mixtures thereof, and metal soap particles having a mean diameter of from 10-300nm, and methods thereof.

Ansmann et al. is applied as discussed above. The reference lacks coatings.

Miles teaches that soap particles coated with an organic material such as starch and gums (col. 2, line 50-col. 3, line 1) overcome the disadvantages of dusting and agglomeration.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the zinc stearate taught by Ansmann et al. with the coating agents taught by Miles because of the expectation of achieving homogeneous metal soap compositions that do not agglomerate.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

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Art Unit: 1617

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lqw
July 30, 2003

Sreeni Padmanabhan
SREENI PADMANABHAN
PRIMARY EXAMINER
7/11/03